No. 712

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960

DEERE & COMPANY,

Petitioner

v.

JOHN W. ENGLAND,

Respondent

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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INDEX

	PAGE
Opinion below	1
Jurisdiction	1
Questions presented	2
Statutes involved	2
Statement	3
Argument	9
Conclusion	14

CITATIONS

Cases:

Armour & Company v. *Wilson & Co.*, 274 F.2d 143	8
The Barbed Wire Patent, 143 U.S. 275	11
Bates vs. *Coe*, 98 U.S. 31	13
Crane Packing Co. v. *Spitfire Tool and Machine Co.*, 276 F.2d 271	13
Graver Tank & Mfg. Co. v. *Linde Air Products*, 336 U.S. 271	9
Hazeltine Research Inc. v. *Avco Manufacturing Corporation*, 227 F.2d 137	8
Ray-O-Vac v. *Goodyear Tire and Rubber Co.*, 321 U.S. 274	11

Statutes:

35 U.S.C.	
Section 103	2, 10
Section 251	2, 12
Section 252	3, 12
Section 282	3, 9, 10

Miscellaneous:

35 C.F.R. 1.71-1.79	12
Walker on Patents, Deller's Edition	13
Rule 52(a) F.R.C.P.	9

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v.

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BRIEF FOR RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States District Court for the Southern District of Illinois, Northern Division, is reported at 182 F.Supp. 133. The opinion of the Court of Appeals for the Seventh Circuit (Pet. App. 21-28) is reported at 284 F2d 460. A Petition for a Rehearing filed December 13, 1960, was denied on January 18, 1961.

JURISDICTION

The judgment of the United States Court of Appeals for the Seventh Circuit was entered on November 28,

1960. The petition for a writ of certiorari was filed on February 18, 1961. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether respondent's patent for a twine holder was properly held valid by the trial court and court of appeals.

2. Whether the Patent Office's reissue of respondent's patent with the retention of the original claims and added narrower claims was legal.

STATUTES INVOLVED

35 U.S.C. 103 provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made;

35 U.S.C. 251 provides in pertinent part:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
>
> . . . .

> The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.
>
> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. 252 provides in pertinent part:

> The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.
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> • • • •

35 U.S.C. 282 provides in pertinent part:

> A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.
>
> • • • •

STATEMENT

The patented device involved in this case is an element of a tying mechanism for twine tie balers. The basic design of the tying mechanism involved has been in use with little change since the advent of the grain reaper-binder in the 19th Century. Subsequent usage has seen the device adapted for use in twine-tie corn binders and more recently, since the early 1940's, on twine-tie hay

balers.[1] The function of the patented device is to hold the twine in place, first, when a hay bale is formed, and, secondly, when the twine is knotted. The twine holder is pressed against a notched disc to hold the twine by a leaf spring bearing down on the top of it.[2]

The respondent, England, is a farmer by occupation. He is also engaged in custom baling. In 1946 he purchased an International 50-T baler (DEERE-App. 16, 29). In his baling, Mr. England found that this baler was not satisfactory when heavy bales were desired or when grain or damp hay was encountered in the field. In such circumstances there was a high percentage of failures of the machine's tying mechanism. The resultant loose or untied bales which were turned out had to be tied by hand. (DEERE-App. 17, 18; ENG-App. 2, 3, 13) Mr. England and others tried to overcome this deficiency by a number of methods. The most apparent remedy of increasing the spring tension on the twine holder against the twine-entraining disc failed to rectify the condition (ENG-App. 6, 7, 13; DEERE-App. 30).

Finally, in August of 1950, Mr. England had a particularly bad day of baling with a large number of untied bales. That night he decided to try out a three-fingered holder to replace a standard equipment on his baler—a two-fingered holder. He spent the night welding a pair of such holders together and installed them on his baler. The results were little less than sensational. In baling operations on the succeeding day there were no untied bales after the first bale. (DEERE-App. 20)

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[1] See pages 14 and 59, Defendant-Appellee's Brief before the Court of Appeals, hereinafter abbreviated "DEERE-App.".

[2] A detailed explanation of the operation of a tying head incorporating respondent's invention may be found on pages 56-57 of Plaintiff-Appellee's Appendix before the Court of Appeals—hereinafter abbreviated "ENG-App.".

He continued to use his discovery experimentally on his own baler for the remainder of the 1950 baling season, and the device continued to be successful. (DEERE-App. 20)

On October 15, 1951, Mr. England filed an application for a patent on his three-fingered holder (Pet. 7; Deere Exh. 6B). The application was first denied by the Examiner as not constituting invention over Hornsby et al, British patent No. 11,419, and several other references were cited. (Pet. 11) Later, upon reconsideration of an amended application, the Examiner, applying the same references, reversed himself, and on April 22, 1952, Patent No. 2,594,140 containing six claims was issued to Mr. England. (DEERE-App. 115-118, Deere Exh. 6B)

After he received his patent, Mr. England began commercial production of the three-fingered holder. It is not disputed that the device met with immediate public acceptance. Mr. England first made by hand some five or six pairs which he sold for $12.50 per pair. He then sold between two and three thousand at $9.95 per pair. His holders were sold with a money-back guarantee if they failed to hold the twine in the disc, but he was never once asked to refund any money. Many farmers brought their tying heads to Mr. England's farm for installation of the twine holders. Later Mr. England lowered the price of his holders to $6.95. At the time of the trial, he had sold approximately eleven thousand additional holders at that price. (DEERE-App. 22-23)

Prior to June, 1954, the petitioner, Deere & Company, did not market a twine-tie baler, (DEERE-App. 13) although it had been manufacturing grain and corn binders equipped with single-fingered twine holders (DEERE-App. 59). However, in 1951 Deere & Company began experimenting in the twine-tie baler field (DEERE-App. 58). On June 9, 1953, Deere & Company purchased three sets of Mr. England's holders to be used in its experi-

mental work which were personally delivered by respondent (DEERE-App. 23-25, 72). Respondent was present at Deere's field trials of his holder which were a success (DEERE App. 25; ENG-App. 10). The twine-tie baler manufactured by Deere & Company was placed on the market about June 1, 1954. These machines were equipped with triple-fingered holders of the type patented by Mr. England (DEERE-App. 13, 71). When Mr. England learned of this, he promptly notified Deere & Company that its holders were infringement of his patent, but Deere & Company replied that it considered that the claims of his patent were anticipated by Cooley patents Nos. 345,674 and 352,081 (ENG-App. 15, Deere Exh. 5H). The Cooley patents disclose a holder wherein the holding elements are secured by a bridgelike arrangement such as shown in defendant's Exhibit 5E (Pet. 6). Such structure may also be found in the patents to Wilkinson and Hornsby, which were cited by the Patent Office Examiner in the original patent (ENG-App. 62, Deere Exh. 6B). At the same time Deere & Company was denying Mr. England's patent, it was advertising the merits of the three-fingered holder in its advertising brochures. (ENG-App. 53-57).

On September 23, 1954, Mr. England filed an application for reissue of his patent. The old claims were all retained and six new claims were added to the original patent. The specification was amended to insert the following: "As seen in Figures 1, 3 and 4, all the longitudinal edges of the said fingers are spaced from each other to provide completely open spaces between the fingers". (DEERE-App. 121) The application specifically invited attention to the aforementioned Cooley patents. (Eng. Exh. 11; ENG-App. 65-67) It was also noted that Mr. England's holder was a replacement for the factory equipped twine holders of International Harvester and New Holland, *inter alia:* (Eng. Exh. 11; ENG-App. 66) On January 18, 1955, the reissue patent was granted em-

bodying the six original claims and six new claims. (DEERE-App. 119-122)

Negotiations were thereafter again commenced with Deere & Company, but to no avail. Finally, on June 9, 1955, Mr. England, by his attorneys, gave final notice to Deere & Company to cease and desist use of the twine holders embodying his invention. Deere & Company, however, now took the position that the open spaced relationship of the three fingers did not constitute invention in view of the prior use by International Harvester and New Holland of two-fingered holders bearing like spaced relationship. (Deere Exh. 5H)

The present suit was filed November 28, 1956. (DEERE-App. 1) The trial of the cause was before U. S. District Judge Frederick O. Mercer without jury. (DEERE-App. 2) Experts and those skilled in the art were called on both sides to testify on the state of the art and the superiority of the three-fingered holder. (ENG-App. 4, 12; DEERE-App. 57, 63, 76) Demonstrations showing the operation of the mechanism involved were performed before the trial judge. (ENG-App. 16-31, 34-36) It was brought out that the three-fingered holder was superior in that it allowed greater slippage of the twine during the critical period of knotting. (ENG-App. 26, 30, 32) Experts of Deere & Company, were of the opinion that the triple-fingered holder did not actually provide more holding power than the one and two-fingered holders of the prior art. (ENG-App. 26, 31, 32) It is interesting to note that this was contrary to the position originally taken by Deere & Company as to why the three-fingered holder was so superior (Deere Exh. 5H). However, several tests were run before the court which showed that Mr. England's three-fingered holder had a definitely superior holding power in contrast to the two-fingered International Harvester holder (ENG-App. 32-36). There was also testimony as to the operability of web-back

holders similar to Deere's Exhibit 5E (Pet. 6). Testimony revealed that when such holders were tested, it was found that the twine would break. It was Mr. England's opinion that the reason for this was that the web-back holder had no flex in it. (ENG-App. 12)

The district court found respondent's patent to be valid and infringed (DEERE-App. 92-112) The court of appeals affirmed the finding that there was substantial evidence to support the trial court's findings and conclusions that respondent's invention was novel and constituted a significant advance in the art (Pet. App. 26). The court further stated (Pet. App. 26):

> . . . . . There was ample evidence to sustain the statutory presumption in favor of the validity of plaintiff's patent. The presumption of validity applied to a Reissue Patent in the same manner as the original Patent. 35 U.S.C. § 252; *Hazeltine Research, Inc.* v. *Avco Manufacturing Corporation*, 7 Cir., 227 F. 2nd 137, 146. In any event, we cannot say the factual determinations of the trial court were clearly erroneous. *Armour & Company* v. *Wilson & Co.*, 7 Cir., 274 F.2d 143.

The court held in reference to the claims in the Reissue Patent which were retained from the original patent (Pet. App. 28):

> Defendant insists that the Reissue Patent must be declared invalid because all the original claims are retained therein. However, this is not a case where the patentee admits he claimed more than he was entitled to in the original patent. It was plaintiff's objective to correct defects in the specification. The six new claims all refer in some way to the changed specification. The right which the patentee had to correct defects in the specification surely gives him the right to include new claims incorporating the corrections.

ARGUMENT

1. The Courts below correctly found respondent's patent to be valid. It will thus be noted that the trial judge heard controversial testimony of expert witnesses on behalf of the respective parties and other witnesses concerning pertinent factual matter, and in addition viewed extensive tests and demonstrations presented by both sides as well as documentary evidence, models and other exhibits. Under Rule 52(a), Federal Rules of Civil Procedure for the United States District Courts, his findings of fact are not to be set aside unless clearly erroneous. This Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products*, 1949, 336 U.S. 271, held Rule 52(a) clearly applicable to a case such as the instant one "where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations."

The presumption of validity which exists in reference to a patent has been codified at 35 U.S.C. 282 *supra*, p. 3 and is abundantly fortified by the evidence.

There has never been any dispute but that respondent's holder was superior. But officials of Deere & Co. seemed unable to agree among themselves as to why this should be so. One Deere witness stated that it would be *inobrious* that respondent's holder would have more holding power, but that its true superiority was that it allowed the twine to slip at the proper time. He felt that the holding power of the twine holder would be essentially the same whether a one-fingered, two-fingered or three-fingered holder were used (ENG-App. 26, 31, 32). However, earlier an official of Deere & Co. had stated that it would be obvious that a three-fingered holder would have more holding power than a two-fingered or one-fingered holder (Deere Exh. 5H). On the other hand, an expert called for petitioner testified that he would expect no

difference in the force required to pull the string out of the twine holder, provided the lateral force is the same whether there are two or three fingers. The only effect of adding a third finger, as he saw it, would be to increase the area of contact and thereby decrease the intensity of lateral force which would have tended to decrease the tendency to break the fibers. (DEERE-App. 92)

This very conflict among petitioner's witnesses would appear, in itself, to negate any charge of obviousness. Actually, it is submitted that the testimony of petitioner's expert sets forth exactly what one probably should expect from a three-fingered hold. It will thus be appreciated that in facing the problem initially, there would be no obvious reason to believe that the addition of a third finger would add to the gripping power of the holder inasmuch as one would expect the gripping characteristics of the holder to be largely determined by the force of the spring bearing down on the holder rather than upon the size of the holder itself. The apparent answer was to increase the spring pressure. This is precisely what Mr. England first tried and what agents for International Harvester had been advised to do—all without success. (ENG-App. 7, 13) Respondent testified to a number of other solutions which he tried to no avail. (ENG-App. 7) A witness for petitioner testified that there were many reasons that a bale might come out of the baler untied. (ENG-App. 24) The actual solution discovered by respondent is one which International Harvester was unable to discover for itself and also which petitioner was unable to discover independently despite an obviously considerable amount of experimentation in the area. Certainly the evidence establishes that respondent's invention falls well within the statutory standards. 35 U.S.C. 103, *supra*, p. 2. Moreover, with the attending statutory presumption of validity under 35 U.S.C. 282, *supra*, p. 3, it was, as pointed out by

the court of appeals, not "for the plaintiff to prove that all the prior art references are overcome. The burden was on the defendant to show lack of inventive distinction. This it has not done." (Pet. App. 28)

In the matter of utility, the evidence is that respondent's invention has produced a new and beneficial result never before attained. It is practically undisputed that when a compact firm bale of hay is desired, prior knotter assemblies left too many untied bales in the field, particularly when green or damp hay was encountered. But respondent's invention overcame this difficulty. Now that the patented device has succeeded, "it may seem plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never obtained before, it is evidence of invention." *The Barbed Wire Patent*, 143 U.S. 275, 283.

Petitioner does not deny respondent's commercial success. Within the space of a few years, the purchasers of over twelve thousand of respondent's holders substituted the patented device for the factory-installed equipment on various types of balers. As stated by the court of appeals: "This is a case for the better mouse trap, for which the public has beaten a path to Mr. England's door to obtain his holder." (Pet. App. 22). Commercial success of an invention is a factor which strengthens the presumption of patentability. *The Barbed Wire Patent*, *supra*; *Ray-O-Vac Co.* v. *Goodyear Tire and Rubber Co.*, 321 U.S. 274.

2. The question of whether the Patent Office had authority to allow narrower claims in the reissue is moot insofar as the ultimate result is concerned. For even if such claims should be found invalid, petitioner still in-

fringes claims carried over from the original application which, under 35 U.S.C. 252, *supra*, p. 3, have effect continuously from the date of the original patent. But aside from the question of mootness, respondent is aware of no authority to the effect that additional claims of a narrower scope cannot be submitted in an application for a reissue patent without an admission by applicant that he was claiming more than he had a right to claim in the original patent. Nor has petitioner presented any such authority. Nor does inspection of 35 U.S.C. 251 and 252, or Rules 171-179, Rules of Practice of the United States Patent Office in Patent Cases, 35 C.F.R. §§ 1.171-1.179, disclose any prohibition such as that contemplated by petitioner. To the contrary, both the statutory provision and rules[3] specifically refer to a situation where "the claims of the original and reissued patents are identical." 35 U.S.C. 252, *supra*, p. 3.

If any restriction such as suggested by petitioner was intended, it is only realistic to conclude that it would have been spelled out in the statutes and regulations in implementation thereof.

Petitioner also takes the position that the infringed claims from the original patent read on the prior art (Pet. 16) of Hornsby, Wilkinson, Cooley and Massey-Ferguson. This contention is without merit. All these references constitute a holder with a continuous back and three ribs which embrace a pair of disks. Apparently the Petitioner overlooks the term "finger" in these claims, in contrast to the rib-type structure disclosed in the

[3] Rule 176 provides: "Examination of reissue. An original claim if re-presented in the reissue application, is subject to re-examination, and the entire application will be examined in the same manner as original application, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications."

prior art.[4] Not only is the term "finger" used in the claims and specification, but the drawings show England's fingers to be fingers as the normal usage of the term would imply—having open spaces between them. It is of course fundamental that in patents, claims are construed in the light of the specification and drawings. *Bates* v. *Coe*, 1878, 98 U.S. 31, 38-39. *Walker on Patents*, Deller's Edition, §§ 260, 261, pp. 1241-1248.

3. While not set forth by petitioner as a question for review, petitioner cites the case of *Crane Packing Co.* v. *Spitfire Tool and Machine Co.*, CCA, Ill. 276 F.2d 271, *cert. denied*, 363 U.S. 820, as constituting a further invalidating state of facts to the reissue patent in this case. However, *Crane Packing Co.* is distinguishable from the facts in this case inasmuch as the added claims in re-

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[4] The claims are as follows:

1. In a tying machine having a pair of spaced apart twine entraining rotary disks, said disks having peripheral twine receiving notches, said twine holder comprising an arm mounted adjacent the periphery of said disks, a central plate-like finger on said arm, said central finger extending between said disks, a pair of plate-like fingers rigidly secured in spaced parallel relation to said central finger, said pair of fingers lying adjacent the outer sides of said twine entraining disks.

2. In a tying machine having a pair of spaced apart twine entraining disks, said disks having peripheral twine receiving notches, a twine holder comprising an arm pivotally mounted adjacent the periphery of said disks, a central finger on said arm, said central finger extending between said disks, a pair of fingers rigidly secured in spaced parallel relation to said central finger, said pair of fingers engaging the outer sides of said twine entraining disks, the face of each of said fingers having an arcuate twine engaging surface or edge portion.

4. A twine holder for use in a tying machine having a pair of step by step twine engaging disks; said twine holder comprising a supporting arm having means adjacent one end for pivotally mounting the same and having a plate-like central presser finger extending therefrom and a pair of plate-like fingers mounted in spaced relation to said first presser finger, said pair of fingers having their adjacent longitudinal edges in the form of arcs.

spondent's reissue are narrower claims than those retained from the original patent. Other distinctions also exist. In any event, it is a moot question because even if the reissue claims should be held inapplicable to the earlier infringement, the original claims would remain valid and infringed.

CONCLUSION

For the reasons stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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